Attorney Docket No. 9792909-4865 (formerly SONY-P7449)   PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of	)	Group Art Unit **2164**
	)	
Tomoyuki Asano	)	Examiner: **Nga B. Nguyen**
	)	
Application No. **08/865,403**	)	
	)	
Filed: **May 29, 1997**	)	
	)	
For: CHARGING SYSTEM AND	)	
CHARGING METHOD	)	

Commissioner for Patents
Washington, D.C. 20231

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APPELLANT'S REPLY BRIEF ON APPEAL

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant submits this Reply Brief in response to the Examiner's Answer. Appellant respectfully submits that the Examiner's analysis in the Examiner's Answer is inconsistent with the Examiner's original analysis in the June 6, 2001, Final Office Action. Thus, for the reasons set forth below, Appellant respectfully requests that this Board reverse the rejections of claims 9, 17-25, 37-46, and 53-62.

I.   EXAMINER'S ANALYSIS IN THE JUNE 6, 2001 FINAL OFFICE ACTION

In the Examiner's Answer, the Examiner indicated that the rejection of claims 9, 17-25, 37-46, and 53-62 under 35 U.S.C. § 102(e) is set forth in the June 6, 2001, Final Office Action. In the Final Office Action, the Examiner identified various sections in Sirbu et al. that allegedly disclose each step in independent claim 9. The Examiner used the same rationale to reject

independent claims 37 and 53. The Examiner's analysis for each step of claim 9 will be discussed in detail below.

A.   receiving a service request requesting desired service for the user from a service provider and a digital signature generated based on service request from a user terminal

The Examiner stated that the first step of claim 9 is disclosed in Sirbu et al. at column 4, lines 35-50 and figure 8. The cited text in Sirbu et al. recites:

> Before a customer begins a typical transaction, the customer will usually contact merchant server 12 to locate information or a service of interest. For example, the customer may request a table of contents of a journal showing available articles, and a list price associated with each article. The transaction begins at a step 1 when the customer requests a formal price quote for a product. That price may be different than the standard list price because, for example, the customer may be part of a site license group, and thus be entitled to a marginal price of zero. Alternatively, by presenting a credential (discussed hereinbelow) the customer may be entitled to some form of discount, or perhaps there is a surcharge during hours of peak usage.

Thus, the examiner related the service request in claim 9 to the "information or a service of interest" for which the customer contacts the merchant server in Sirbu et al. The service provider in claim 9 (corresponding to the merchant server in Sirbu et al.) receives the service request for the user (corresponding to the customer in Sirbu et al.).

B.   providing the service to the user terminal according to service request

The Examiner stated that the next step of claim 9 is disclosed in Sirbu et al. at column 9, lines 30-37. The cited text in Sirbu et al. recites:

> The merchant generates a unique symmetric cipher key K, encrypts the goods using the key and sends the encrypted goods to the customer along with the first cryptographic checksum computed on the encrypted goods, so that the customer will immediately detect any discrepancy before proceeding. The merchant also sends an electronic payment order ID, or EPOID, 50 (See FIG. 10) with the encrypted goods.

As in the previous step, the user in claim 9 corresponds to the customer in Sirbu et al., and the service provider in claim 9 corresponds to the merchant server in Sirbu et al. Accordingly, the merchant provides the goods, the checksum computed on the encrypted goods, and an EPOID to the customer according to the customer's request.

C.   **requesting a charge collection from an accounting terminal based on service request**

The Examiner stated that the next step of claim 9 is disclosed in Sirbu et al. at column 6, lines 20-37. The cited text in Sirbu et al. recites:

> The account server 16 verifies that the customer and merchant signatures are valid, verifies that the customer has the funds needed for the transaction as well as checking the validity of any credentials. The EPOID is reviewed to make sure this is not a replay of a previous transaction, and the timestamp is reviewed to insure that the transaction is not stale. If the review is positive, meaning that all the information is valid, the customer has the necessary funds or credit in the customer's account, and the timestamp is valid, the account server 16 debits the customer's account and credits the merchant's account, logs the transaction, and saves a copy of the decryption key. The account server 16 returns to the merchant at step 7 a digitally signed message containing an approval, or an error code indicating why the transaction failed, and the key. The merchant application software forwards the account server message and (if appropriate) the decryption key to the customer's checkbook library 30 at step 8.

Although it is unclear from the cited text that a charge collection is requested from an accounting terminal, the preceding paragraph in Sirbu et al. verifies that the service provider (i.e., merchant) sends a charge collection request (in the form of a countersigned EPO) to the accounting terminal (i.e., the account server), and that after verification, the accounting terminal debits the user's account, credits the service provider, and sends an approval (or an error code) to the service provider.

D.   providing service request and digital signature to accounting terminal when a disclosure request of service requests and digital signatures is received

The Examiner stated that the next step of claim 9 is disclosed in Sirbu et al. at column 6, lines 12-18. The cited text in Sirbu et al. recites:

> If the first and second checksums match, the merchant application software adds to the EPO the merchant's account number, a merchant memo field, an electronic signature, and the key needed to decrypt the good to create a countersigned EPO 42. (See FIG. 9). The merchant application software sends the countersigned EPO 42 to the account server 16 at step 6 for review.

In this step, the countersigned EPO (which includes the EPO, the merchant's account number, a merchant memo field, an electronic signature, and the key needed to decrypt the good) is provided to the account server (accounting terminal). As disclosed in column 5, line 63 through column 6, line 2, the EPO may include customer identity, product identifier, negotiated price, merchant identifier, the second cryptographic checksum, the EPOID (electronic payment order ID) containing the timestamp, a digital signature, the merchant's account number, a merchant memo field, an electronic signature, and the key needed to decrypt the good. Thus, as discussed in Appellant's Appeal Brief, Sirbu et al. does not include the service request (i.e., the request for the information or service of interest) as part of the countersigned EPO. In addition, no disclosure request of service requests and digital signatures is received by the service provider.

II.   EXAMINER'S ANALYSIS IN THE EXAMINER'S ANSWER

In order to overcome the missing items in the claims, the Examiner now provides an alternate analysis of Sirbu et al. that is inconsistent with the Examiner's original analysis. In particular, the Examiner now states:

It is clearly in Sirbu that the merchant providing a countersigned electronic payment order included customer's digital signature to account server when the merchant already received the electronic payment order with customer's digital signature from the customer (see column 5, line 44 through column 6, line 37). When the customer requests for a service from the merchant, he/she submits an electronic payment order with customer's digital signature to the merchant, the merchant endorses the electronic payment order already received from the customer (a disclosure request) to create a countersigned electronic payment order (a service request) and forwards the countersigned electronic payment order to account server for verifying. . . . Therefore, in Sirbu, the electronic payment order already submitted by the customer to the merchant is equivalent to the disclosure request, the countersigned electronic payment order is equivalent to the service request that the merchant sends to the account server.
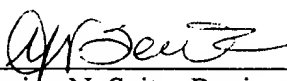
Thus, although in the Final Rejection the Examiner appeared to argue that the service request corresponded to the request for the information or service of interest, the Examiner now claims that the service request corresponds to the countersigned EPO. Following the Examiner's new reasoning, which is different from that in the Final Office Action, because the merchant sends the countersigned EPO to the account server, the merchant now corresponds to the user and the account server now corresponds to the service provider. Under the Examiner's new scenario, however, the Examiner fails to identify which entity in Sirbu et al. corresponds to the accounting terminal. Moreover, after the account server receives the countersigned EPO, Sirbu et al. does not disclose nor suggest that the account server provide the countersigned EPO to an accounting terminal, as required by the fourth step of claim 9. The Examiner is essentially mixing apples and oranges in his new analysis. Accordingly, Appellant respectfully submits that in trying to identify a missing element in Sirbu et al., the Examiner has created a new scenario that is not supported by the disclosure of Sirbu et al.

V.   <u>CONCLUSION</u>

For the foregoing reasons, Appellant respectfully submits that the Examiner's Answer

does not overcome Appellant's Appeal Brief.   Therefore, Appellant respectfully requests that this

Board reverse the rejections proposed by the Patent Office.

Respectfully submitted,

Dated: <u>July 18, 2002</u>   By: _____

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